

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket № 14967US02

In the Application of:

Jeyhan Karaoguz, et al.

Electronically Filed on June 1, 2011

**Appeal No. 2010-004430**

Serial No.: 10/667,036

Filed: September 22, 2003

For: BILLING SUPPORT IN A  
MEDIA EXCHANGE NETWORK

Examiner: HAMILTON, LALITA

Group Art Unit: 3691

Conf. No.: 7866

**REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Appellants request a rehearing with respect to the Decision on Appeal for the matter identified above that was mailed May 11, 2011 (the "Decision"). This Request is timely because it is being filed within two months of that date.

The Appellants requests a rehearing because the Decision seemingly misapprehends or overlooks:

(1) that claim 40 recites, in part, "at least one user defined media channel," and neither Schein nor Future TV provide an enabling disclosure that describes, teaches, or suggests such a limitation;

(2) that claim 46 recites, in part, "coordinating delivery of the media content from the at least one server at the **first** location to a storage at a **second** location to a television display at a **third** location for consumption; and

(3) that functional limitations recited in claim 46 are, indeed, to be considered and given patentable weight.

I. **The Appellants Request Clarification That The Rejection Of Claims 1-39 Is NOT Sustained**

As an initial matter, the Decision states the following:

The rejection of claims 1-39 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is **improper**.

The rejection of claims 40-53 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is proper. ...

To summarize, our decision is as follows.

The rejection of **claims 1-39** under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV **is not sustained**.

The rejection of claims **1-53** under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is sustained.

See Decision at page 7 (emphasis added). The Appellants respectfully submit, however, that the rejection of claims 1-39 is not sustained. This appears to be a

typographical error. Instead, the Decision should indicate that the rejection of claims 40-53, but not 1-53, is sustained. Therefore, the Appellants request clarification.

Additionally, the Appellants respectfully request reconsideration of the rejection of claims 40-53 as being unpatentable over Schein in view of Future TV for at least the reasons set forth below.

## **II. Claims 40-45**

The Appellants turn to claim 40, which recites, in part, "a user interface for the selection and display of media content, the user interface allowing **at least one user to create at least one user defined media channel**, wherein the at least one user selects media content for the **at least one user defined media channel** through the user interface, and the at least one user specifies, through the user interface, times when the user selected media content will be made available via the **at least one user defined media channel**, the user interface displaying a graphical representation of the **at least one user defined media channel** comprising a sequence of the user selected media content for consumption at the times specified by the at least one user." Thus, the claim is clear that the interface allows "at least one user to create at least one user defined media channel."

However, there is no enabling disclosure in Schein or Future TV that expressly or necessarily describes a user-defined media channel, in general. Indeed, the Decision acknowledges that "We agree with the Appellants that the Examiner made no findings that such a user defined media channel was described by Schein." See Decision at page 5, lines 21-23. Indeed, the Decision states that "Schein does not explicitly create such a user defined media channel." See *id.* at page 6, lines 10-11.

The Decision seemingly relies on Future TV to overcome the acknowledged deficiency of Schein. *See id.* at page 6, lines 11-14. In particular, the Decision states that "Future TV explicitly states that the technology it describes was already in the possession of those of ordinary skill. FF 06." *See id.* at page 6, lines 13-13.

FF 06 states that "[t]he technology to implement Future TV existed at the time of publication, and so was known to those of ordinary skill. Future TV **35**." *See id.* at page 5, lines 16-18 (emphasis added). Notably, the Decision relies on Future TV at page 35 as overcoming the acknowledged deficiency of Schein.

However, there is nothing in Future TV at page 35 that explicitly or necessarily describes, teaches, or suggests a "user interface allowing **at least one user to create at least one user defined media channel**, wherein the at least one user selects media content for the **at least one user defined media channel** through the user interface, and the at least one user specifies, through the user interface, times when the user selected media content will be made available via the **at least one user defined media channel**, the user interface displaying a graphical representation of the **at least one user defined media channel** comprising a sequence of the user selected media content for consumption at the times specified by the at least one user," as recited in claim 40.

While Future TV at page 35 indicates a "remote control," "cable TV channels," a "program guide," a "cable company," a "video," "Internet movies," a "small screen," "tired broadcasters," "display technology," "digital entertainment," "video games," "music," "digital content," "distribution channels," and "one big broadband pipe," there is nothing in Future TV that provides an enabling disclosure that expressly or necessarily

describes a “user defined media channel,” as recited in claim 40. Further, as noted above, the Decision acknowledges that Schein also does not describe, teach, or suggest a “user defined media channel.” See Decision at page 5, lines 21-23 and page 6, lines 10-11. Indeed, neither the Examiner’s Answer, nor the Decision, point to anything in Schein or Future TV that provides an enabling disclosure that expressly or necessarily describes, teaches, or suggests a “user defined media channel,” as recited in claim 40.

A recent Federal Circuit case clarifies the nature of a *prima facie* case of unpatentability. In particular, *In re Kao* states that the “examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Glaug*, 283, F.3d 1335, 1338 (Fed. Cir. 2002).” *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (attached). Moreover, the Examiner must support conclusions of obviousness with “**substantial evidence.**” See *id.* (emphasis added). “Substantial evidence is such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *In re Kumar*, 418 F.3d 1361, 1366-67 (Fed. Cir. 2005). However, “conjecture does not supply the requisite substantial evidence to support the rejections ....” See *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011). Further, conclusory reasoning does not supply the requisite substantial evidence. See *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (“**the Board should neither rely upon conclusory reasoning nor its own conjecture in assessing the weight of evidence**”).

As explained above, neither the Examiner’s Answer, nor the Decision, provide any evidence that any of the cited references expressly or necessarily describes,

teaches, or suggests a user-defined media channel, as recited in claim 40. For at least these reasons, the Appellants respectfully request reconsideration of the rejection of claim 40 and the claims depending therefrom.

### **III. Claims 46-53**

The Appellants now turn to the rejection of claims 46-53.

#### **A. Three Locations**

Independent claim 46 recites, in part, "server software that receives via a communication network a request for the delivery of the media content from the at least one server at the first location, the request comprising information securing payment for delivery, and that responds by coordinating the delivery of the media content **from the at least one server at the first location to a storage at a second location to a television display at a third location** for consumption." As shown, the claim recites a server at a first location, a storage at a second location, and a television display at a third location.

The Decision states that "We are unpersuaded by the Appellants' argument that Schein fails to describe the server, computer, and TV since Schein receiver requests for a guide at a server, from which the guide is downloaded to a local computer for display on a screen or TV. FF 04." See Decision at page 6, lines 16-19. Notably, the Decision only accounts for **two** locations, but not three. Again, as noted above, claim 46 recites that the server is at the first location, the storage is at the second location, and the television display is at the third location.

Further, FF 04, which the Decision relies on, cites to Schein at "14:56-64." See Decision at page 5, lines 7-12. However, this cited portion of Schein states the following:

In another embodiment, the television schedule guide (not shown) is stored as one or more files (e.g., a websites [sic] or internet broadcast transmitters) on one of the servers 350, which can be accessed by any viewer having access to the World Wide Web. The television schedule guide or website may be configured for viewing and interacting with television information directly on-line, or it may be configured for downloading the information into a computer hard drive or other suitable processor.

See Schein at column 14, lines 56-64. This cited portion of Schein simply notes a guide stored "on one of the servers," and viewing "on-line" or downloaded to a "computer hard drive." That is, the cited portion merely notes the possibility of two locations, but not three. The Appellants respectfully submit, however, that neither the Examiner's Answer, nor the Decision, points to anything in the cited references that expressly or necessarily describes, teaches, or suggests server software that coordinates delivery of media content from a **server at a first location** to a **storage at a second location** and then onto a **television at a third location**, as recited in claim 46. Thus, for at least these reasons, the Appellants respectfully request reconsideration of the rejection of claims 46-53.

**B. Request Reconsideration Of The Assertion That "Data Content Securing Payment For Delivery Is Given No Patentable Weight"**

Additionally, the Decision states the following:

The data content securing payment for delivery is given no patentable weight in a structural system claim, which is defined by the structure of the system and not the contents of its data input.

"[E]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claims." *Ex parte Thibault*, 164, USPQ 666, 667 (Bd.App. 1969).

Furthermore, "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Otto*, 312, F.2d 937, 940 (CCPA 1963).

See Decision at page 6, line 19 to page 7, line 3. However, as explained below, these statements of law are seemingly at odds with more recent Federal Circuit case law and the MPEP:

It has long been "well settled that there is nothing intrinsically wrong in defining something by what it does rather than by what it is." *In re Hallman*, 655 F.2d 212, 215 (C.C.P.A. 1981). Even in a system or apparatus claim, "[t]he functional language is, of course, **an additional limitation in the claim.**" *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (considering functional language for an apparatus claim directed to an in-line roller skate) (emphasis added); *see also Microprocessor Enhancement Corp. v. Tex. Instruments Inc.*, 520 F.3d 1367, 1375 (Fed. Cir. 2008) ("Functional language **may also be employed to limit the claims** without using the means-plus-function format.").

Likewise, a statement of purpose (i.e. intended use) can act as a limitation that serves to differentiate the prior art. *See, e.g., In re Stencel*, 828 F.2d 751, 755 (Fed. Cir. 1987) ("[The patentee] is not inhibited from claiming his driver, limited by the statement of its purpose, and further defined by the remaining clauses of the claims at issue, when there is no suggestion in the prior art of a driver having the claimed



structure and purpose." (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)) (emphasis added)).

The MPEP is in accord with these and other cases, recognizing that "[t]here is nothing inherently wrong with defining some part of an invention in functional terms," and that "[f]unctional language does not, in and of itself, render a claim improper." MPEP § 2173.05(g) (citing *In re Swinehart*, 439 F.2d 210 (C.C.P.A. 1971)). Moreover, the MPEP states:

**A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.**

MPEP § 2173.05(g) (emphasis added).

For at least these reasons, the Appellants respectfully request the Board to reconsider its assertion that "data content securing payment for delivery is given no patentable weight."

#### **IV. Conclusion**

For at least the reasons discussed above, the Appellants respectfully submit that the Board overlooked or misapprehended the following:

(1) that claim 40 recites, in part, "at least one user defined media channel," and neither Schein nor Future TV provide an enabling disclosure that expressly or necessarily describes, teaches, or suggests such a limitation;

(2) that claim 46 recites, in part, "coordinating delivery of the media content from the at least one server at the **first** location to a storage at a **second** location to a television display at a **third** location for consumption"; and

(3) that certain functional limitations recited in claim 46 are, indeed, to be considered and given patentable weight.

Therefore, the Appellants respectfully request: (1) clarification that the rejection of claims 1-39 has **not** been sustained, and (2) that the rejection of claims 40-53 be reversed.

The Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: June 1, 2011

/Joseph M. Butscher/  
Joseph M. Butscher  
Registration No. 48,326

McANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
(312) 775-8000  
(312) 775-8100 (fax)